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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/706,911

11/14/2003

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EXAMINER

MURDOUGH, JOSHUA A

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/706,911	<b>Applicant(s)</b> CLARK, JACK ROBERT ARRON	
	<b>Examiner</b> JOSHUA MURDOUGH	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12,14-22,24-32 and 34-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12,14-22,24-32 and 34-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgements***

1. In response to Applicant's amendment, received on 13 December 2007, claims 3, 13, 23, and 33 have been canceled and new claims 41 and 42 have been added.
2. Claims 1, 2, 4-12, 14-22, 24-32, and 34-42 are currently pending.

### ***Claim Objections***

3. Claims 1, 2, 4-12, 14-22, 24-30, 41, and 42 are objected to because of the following informalities: Claim 1, recites "A method distributing." It is recognized that it is actually the performance of the method that causes the results and not the method itself. Therefore, the Examiner believes it should read either, "A method for distributing" or "A method of distributing." Claims 11 and 21 have similar issues. Appropriate correction is required.
4. Claims 32 and 34-40 are objected to because of the following informalities: The claims recite, "A software supply controlling computer program as claimed" in claim 31 or one of its dependents. The scope of claim 31 includes the computer readable medium. Therefore, any claim depending from claim 31, either directly or indirectly, should reference the medium as well as the program. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 4, 5, 8-12, 14, 15, 18-22, 24, 25, 28-32, 34, 35, and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi (US 7,124,443).

7. As to claims 1, 11, 21, and 31, Ishibashi shows:

A method distributing a computer program product, said method comprising the steps of:

obtaining a licence ticket (Contents Use Right Discrimination Card, between 603 and 601, Figure 3) bearing a licence key (Discriminating Data, Figure 3);

inputting at a user computer **601** a download source computer address of a download source computer **603** of a supplier of said computer program (Column 8, line 45) product (The address has to be know to the user computer in order to have the download initiated, therefore, it had to be inputted);

establishing a computer network connection **607** between said user computer and said download source computer;

inputting said licence key at said user computer (Right arrow from Contents Use Right Discrimination Card to 601, Figure 3);

transmitting said licence key from said user computer via said computer network connection (Arrow from 601 to 605, Figure 3);

validating said licence key (Column 10, lines 4-13); and

if said licence key is valid, then:

(i) downloading said computer program product to said user computer (Column 9, lines 25-27); and

(ii) installing said computer program product to be resident upon said user computer (the decryption, as shown by Ishibashi, Columns 3-4, lines 62-10, is considered to place the program in position for use).

wherein when said licence ticket is purchased a seller of said licence ticket transmits data indicating sale of said licence ticket to said supplier of said computer program product (In order for the sale center **605** to know that the serial number has been distributed, it had to be reported by the seller, Column 10, lines 4-13).

Ishibashi shows the provider **603** and the management center **605** as separate servers.

However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the teachings of Ishibashi to combine the two servers in order to make them integral (MPEP 2144.04), thus reducing the hardware and communications requirements.

8. As to claims 2, 12, 22, and 32, Ishibashi further shows:

said licence ticket is obtained via a purchase by a user (Column 9, lines 13-19).

9. As to claims 4, 14, 24, and 34, Ishibashi further shows:

receipt of said data indicating sale of said licence ticket validates said licence key associated with said licence ticket such upon subsequent receipt of said licence key at said download source computer said licence key will be treated as valid (if the serial number has been distributed, and the data from the user is proven authentic, Column 10, lines 4-13, it is treated as valid).

10. As to claims 5, 15, 25, and 35, Ishibashi further shows:

said data indicating sale of said licence ticket indicates one or more computer program products of which download and installation is to be allowed by said licence key of said licence ticket (Figure 4, the program/content ID corresponds to the key/serial number).

11. As to claims 8, 18, 28, and 38, Ishibashi further shows:

said licence key is hidden upon said licence ticket so as to be non-reversibly revealable by said user (Column 8, lines 65-67).

12. As to claims 9, 19, 29, and 39, Ishibashi further shows:

said licence key is hidden behind a scratch off covering upon said licence ticket (Column 8, lines 65-67).

13. As to claims 10, 20, 30, and 40, Ishibashi further shows:

said licence ticket bears a licence ticket identifier used to identify licence tickets released to be available to be obtained by a user (Column 8, lines 60-65).

14. As to claim 41, Ishibashi further shows:

said license ticket includes a front side and a back side (inherent for anything tangible, such as a card)

15. Claims 6, 16, 26, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi as applied to claims 1, 11, 21, and 31 above, and further in view of Official Notice.

16. Ishibashi shows as is described in the rejection of claims 1, 11, 21, and 31 above, but does not show:

receipt of said data indicating sale of said licence ticket triggers said supplier of said computer program product to charge said seller for a licence to use said computer program product.

However, the Examiner believes this to merely be sale by consignment. The Examiner takes official notice that it is notoriously old and well known in the art to sell goods by consignment. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Ishibashi to use consignment in order to reduce the risk on the part of the seller, which makes them more likely to carry the product.

17. Claims 7, 17, 27, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi as applied to claims 1, 11, 21, and 31 above, and further in view of Powell (US 2001/0032189).

18. Ishibashi shows as is described in the rejection of claims 1, 11, 21, and 31 above, but does not show:

if said licence key is valid, then a user account is created associated with said licence key.

However, Powell shows the creation of a user account **268** upon verification of payment for a license (Paragraph 0167 & Title). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Ishibashi with the user account of Powell, in order to save user preferences (Powell, paragraph 0167) and have better records and control of the transactions and content.

19. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi as applied to claim 1 above, and further in view of Berson (US 5,598,477).

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20. Ishibashi shows as is described in the rejection of claim 1 above, but does not show:

said licence ticket includes a bar code identifying said license ticket.

However, Berson shows the use of a bar code **22BC** on a ticket, used to validate it (Column 3, lines 51-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Ishibashi to include the barcode as described by Berson, in order to allow for the input to be scanned instead of manually input and to encrypt the data (Berson, Column 3, lines 55-56).

### ***Claim Interpretations***

21. To the extent that the Examiner's interpretations are in dispute with Applicants' interpretations, the Examiner hereby adopts the following definitions—under the broadest reasonable interpretation standard—in all his claim interpretations.<sup>1</sup> Moreover, while the following list is provided in accordance with *In re Morris*, the definitions are a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

**Install** – “v. 3 to set up for use or service.” (Webster's Third New International

Dictionary, Unabridged, 1993 Merriam-Webster, Incorporated.)

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<sup>1</sup> While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.



**License/Licence** – “n. 3 a (1) : a right or permission granted in accordance with law by a competent authority to engage in some business or occupation, to do some act, or to engage in some transaction which but for such license would be unlawful.  
(2) : a document evidencing a license granted” (Id.)

**Ticket** – “n. c : a written, typed, printed, stamped, or engraved notice, record, memorandum, or token: as  
(1) : a paper or card on an item giving information (as of its owner, identity, maker, or price)” (Id.)

22. Also, Applicants use of optional language (e.g. “if” in claim 1) allows for the “if not” option to read on the claim. While the Examiner has addressed the optional limitations in this action, it is the Examiner’s opinion that these limitations do not distinguish the claim from the prior art. See MPEP 2106 II C (Paragraph 4+). A positive recitation of the limitations would prohibit this interpretation.

### ***Response to Arguments***

23. Applicant's arguments with respect to the Ellis reference have been considered but are moot in view of the new ground(s) of rejection.

24. Applicant’s arguments with respect to the 35 USC 112 1<sup>st</sup> and 2<sup>nd</sup> paragraph rejections have been considered. Due to Applicant’s statement that the claim terms were to be given their plain and ordinary meanings, the Examiner has withdrawn these rejections.

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25. Applicant's arguments with respect to the 35 USC 101 rejections of claims 8, 9, 18, 19, 28, 29, 38, and 39 have been considered. Due to Applicant's statement that the claim terms were to be given their plain and ordinary meanings, the Examiner has withdrawn these rejections.

### ***Conclusion***

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

27. Stefik (US 5,629,980) shows the use of a digital ticket used to enforce license provisions on digital contents.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

30. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.

Examiner, Art Unit 3621

/ANDREW J. FISCHER/

Supervisory Patent Examiner, Art Unit 3621